

rejected claims 17, 35-36 and 38 under 35 U.S.C. § 112, second paragraph, as being indefinite; rejected claims 22-25 and 39-43 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,423,558 to Koeth et al.; and rejected claim 34/22 under 35 U.S.C. § 103(a) as being unpatentable over Koeth et al. in view of U.S. Patent No. 4,944,119 of Gill, Jr. et al.. The Examiner also indicated that claims 1-21, 26-33, 34/30 and 37 are allowed; and that claims 17, 35-36, and 38 would be allowable if amended to overcome the rejections under 35 U.S.C. § 112, second paragraph. In this Amendment, Applicants have added new claims 44-48. Claims 1-48 remain pending in this application.

Applicants thank the Examiner for the indication of allowable subject matter in claims 1-21, 26-33, 34/30, and 35-38.

Applicants have added new claims 44-48 to further define features of their invention. In accordance with the requirements of 37 C.F.R. 1.121(b)(2)(iii), Applicants provide the following explanation of the support in the disclosure of U.S. Patent No. 5,476,414 for which this reissue application was filed, for each of the newly-added claims. Claim 44 is supported in the disclosure at column 8, line 31-column 9, line 38 and by Figs. 14 and 15. Claim 45 is supported in the disclosure at column 8, lines 42-53 and column 9, lines 16-38, and by Figs. 14 and 15. Claim 46 is supported in the disclosure by column 8, lines 35-41 and by Fig. 14. Claim 47 is supported in the disclosure at column 9, line 41-column 10, line 1 and by Fig. 16. Claim 48 is supported in the disclosure at column 8, lines 36-41 and by Fig. 14.

LAW OFFICES

FINNEGAN, HENDERSON,  
FARABOW, GARRETT  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
WASHINGTON, D. C. 20005  
202-408-4000

In response to the Examiner's indication that the original patent must be received before the reissue application can be allowed, applicants are filing concurrently herewith a Submission of Original Patent. In view of the Submission, Applicants respectfully submit the application meets the requirements of 37 C.F.R. 1.178.

Applicants respectfully traverse the Examiner's grounds for finding the reissue declaration to be defective. First, the Examiner indicates the Reissue Declaration is defective because it fails to identify at least one error which is relied upon to support the Reissue Declaration. However, paragraph 6 of the Reissue Declaration fully recites that the error being relied upon as the basis for reissue is that the Applicants "claimed less than [they] had a right to claim" with respect to the subject matter of independent claim 12. The Examiner further states that applicants must distinctly specify the excess or insufficiency in the claims and asks the questions "[w]hat limitation(s) in the claims of US patent 5,476,414 are considered by Applicants to be too narrow, or otherwise unnecessary for patentability?" Applicants again respectfully direct the Examiner's attention to paragraph 6 of the Reissue Declaration which explicitly states that the Applicants had claimed less than they had a right to claim "in that independent claim 12 recites a polishing apparatus comprising a combination of features including a top ring holder, a plurality of retaining members extending through the top ring holder and a plurality of springs between the top ring holder and retaining members, while our invention is not so limited." Therefore, contrary to the Examiner's position, Applicants have clearly

specified the excess in the claims with reference to specific limitations in a particular claim.

In paragraph 6 of the Office Action, the Examiner further states that the Reissue Declaration is defective because it fails to particularly specify the errors and how the errors relied upon arose or occurred as required under 37 C.F.R.

1.175(a)(5). The Examiner further states that "[a]pplicants' [sic] are required to specify how and when these errors arose, as well as how and when these errors were discovered." As noted above, paragraph 6 of the Reissue Declaration particularly specifies the error relied upon to support the reissue application.

Consistent with the amendment of 37 C.F.R. 1.175 effective December 1, 1997, applicants are no longer required to specify how and when an error identified in the Reissue Declaration arose or how and when such error was discovered. This change in reissue practice is further explained in Manual of Patent Examining Procedures § 1414, II, which states in pertinent part, "[i]t is not necessary, however, to point out how (or when) the error arose or occurred. Further, it is not necessary to point out how (or when) the error was discovered." (emphasis in original).

Applicants therefore respectfully submit that the Reissue Declaration fully meets the requirements of 37 C.F.R. 1.175.

In view of Applicants' remarks regarding the adequacy of their Reissue Declaration, Applicants respectfully request that the Examiner withdraw his objections to the Reissue Declaration and rejection of claims 1-43 based on the alleged defects in the Reissue Declaration.

Applicants respectfully traverse the Examiner's rejection of claims 17, 35-36, and 38 under 35 U.S.C. § 112, second paragraph. In particular, the Examiner states that in claim 17, lines 9-12, it is unclear what element corresponds to the recited "plate . . . ". The Examiner raises the same question regarding claims 35 and 38 regarding the recitation of the "pressure adjuster . . . ." The "plate" recited in claim 17 and the "pressure adjuster" recited in claims 35 and 38 correspond to the pressure adjusting member 37 shown in Fig. 10 and described at column 7, lines 40-56. Applicants note that pressure adjusting member 37 includes an annular lower projection 37b that contacts the upper surface of top ring 3. Applicants therefore respectfully submit that claims 17, 35, 36, and 38 meet the requirements of 35 U.S.C. § 112, second paragraph, and request that the Examiner withdraw his rejection.

Applicants respectfully traverse the Examiner's rejection of claims 22-25 and 39-43 under 35 U.S.C. § 102(b) as anticipated by Koeth et al.. Koeth et al. is not available as prior art under Section 102(b) against the claims of this reissue application since Koeth et al. issued on June 13, 1995, which is later than the original U.S. filing date of September 22, 1993 of U.S. Patent No. 5,476,414 upon which this reissue application is based and the benefit of which this application is entitled. Applicants therefore respectfully request the Examiner to withdraw his rejection.

Applicants further note that Koeth et al. is also not available as prior art under § 102(e) since its filing date of March 24, 1994 is also later than the U.S. filing date of U.S. Patent No. 5,476,414.

Applicants respectfully traverse the Examiner's rejection of claim 34/22 under 35 U.S.C. § 103(a) as unpatentable over Koeth et al. in view of Gill, Jr. et al.. For the reasons noted above, Koeth et al. is not available as prior art against the claims of this reissue application. Therefore this rejection under Section 103(a) cannot be maintained and the Examiner is respectfully requested to withdraw the rejection.


In view of the above amendments and remarks, Applicants respectfully submit that pending claims 1-48 are in condition for allowance. A favorable action is requested.

If there is any fee due in connection with the filing of this Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:

  
Richard V. Burgujian  
Registration No.: 31,744

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